

## PATENT COOPERATION TREATY

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## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference X-15440	<b>FOR FURTHER ACTION</b>		See Form PCT/IPEA/416
International application No. PCT/US 03/35055	International filing date (day/month/year) 20.11.2003	Priority date (day/month/year) 22.11.2002	
International Patent Classification (IPC) or national classification and IPC C07C59/90			
<p><b>Applicant</b>  <b>ELI LILLY AND COMPANY</b></p> <p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 6 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> <i>sent to the applicant and to the International Bureau</i> a total of sheets, as follows:</p> <ul style="list-style-type: none"> <li><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</li> <li><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</li> </ul> <p>b. <input type="checkbox"/> <i>(sent to the International Bureau only)</i> a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p> <p>4. This report contains indications relating to the following items:</p> <ul style="list-style-type: none"> <li><input checked="" type="checkbox"/> Box No. I Basis of the opinion</li> <li><input type="checkbox"/> Box No. II Priority</li> <li><input checked="" type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</li> <li><input type="checkbox"/> Box No. IV Lack of unity of invention</li> <li><input checked="" type="checkbox"/> Box No. V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</li> <li><input type="checkbox"/> Box No. VI Certain documents cited</li> <li><input checked="" type="checkbox"/> Box No. VII Certain defects in the international application</li> <li><input checked="" type="checkbox"/> Box No. VIII Certain observations on the international application</li> </ul>			
Date of submission of the demand 15.06.2004	Date of completion of this report 19.07.2004		
Name and mailing address of the international preliminary examining authority:   European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer  Cooper, S Telephone No. +49 89 2399-8323		



## **INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**

International application No.  
PCT/US 03/35055

### **Box No. I Basis of the report**

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

This report is based on translations from the original language into the following language, which is the language of a translation furnished for the purposes of:

international search (under Rules 12.3 and 23.1(b))

publication of the international application (under Rule 12.4)

international preliminary examination (under Rules 55.2 and/or 55.3)

2. With regard to the **elements\*** of the international application, this report is based on (*replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report*):

### Description, Pages

1-243 as originally filed

## **Claims, Numbers**

1-29 as originally filed

- a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3.  The amendments have resulted in the cancellation of:  
 the description, pages  
 the claims, Nos.  
 the drawings, sheets/figs  
 the sequence listing (*specify*):  
 any table(s) related to sequence listing (*specify*):

4.  This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).  
 the description, pages  
 the claims, Nos.  
 the drawings, sheets/figs  
 the sequence listing (*specify*):  
 any table(s) related to sequence listing (*specify*):

\* If item 4 applies, some or all of these sheets may be marked "superseded."

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**Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:
  - the entire international application,
  - claims Nos. 20-23,25,29
    - because:
  - the said international application, or the said claims Nos. claims 20-23,25,29 relate to the following subject matter which does not require an international preliminary examination (specify):  
**see separate sheet**
- the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):
- the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.
- no international search report has been established for the said claims Nos.
- the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:

the written form	<input type="checkbox"/> has not been furnished
	<input type="checkbox"/> does not comply with the standard
the computer readable form	<input type="checkbox"/> has not been furnished
	<input type="checkbox"/> does not comply with the standard
- the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-*bis* of the Administrative Instructions.
- See separate sheet for further details

**INTERNATIONAL PRELIMINARY REPORT  
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**Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes:	Claims	1-29
	No:	Claims	
Inventive step (IS)	Yes:	Claims	1-29
	No:	Claims	
Industrial applicability (IA)	Yes:	Claims	1-19,24,26-28
	No:	Claims	

2. Citations and explanations (Rule 70.7):

**see separate sheet**

**Box No. VII Certain defects in the international application**

The following defects in the form or contents of the international application have been noted:

**see separate sheet**

**Box No. VIII Certain observations on the international application**

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

**see separate sheet**

**INTERNATIONAL PRELIMINARY  
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(SEPARATE SHEET)**

International application No.

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D1 = US-A-6 218 430

**Section III.**

- 1). For the assessment of the present claims 20-23,25 and 29 on the question whether they are industrially applicable, no unified criteria exist in the PCT Contracting States. The patentability can also be dependent upon the formulation of the claims. The EPO, for example, does not recognize as industrially applicable the subject-matter of claims to the use of a compound in medical treatment, but may allow, however, claims to a known compound for first use in medical treatment and the use of such a compound for the manufacture of a medicament for a new medical treatment.
- 2). Claims 20-23,25 and 29 relate to subject-matter considered by this Authority to be covered by the provisions of Rule 67.1(iv) PCT. Consequently, no opinion will be formulated with respect to the industrial applicability of the subject-matter of these claims (Article 34(4)(a)(I) PCT).

**Section V.**

- 1). The presently claimed compounds differ from those according to D1 in the group Zc which in the present compounds is connected to the diphenyl methane nucleus via a carbon atom and in D1 via N,O or S. In addition, the present Zc groups, which are individually defined, have more reactive functionality than the corresponding groups in D1 (in the present application are acids, esters, amides, sulphones, heterocycles etc; in D1 they are ethers, alcohols, amines etc)
- 2). A representative selection of the present compounds has been shown to have modulatory activity on vitamin D receptors. This makes them of interest in the treatment of a broad spectrum of medical conditions including osteoporosis, psoriasis, prostate cancer and those mentioned on p.4, lines 13-21 of the present application.
- 3). The compounds according to D1 have a similar spectrum of activity. However, in view of the structural differences between the compounds according to D1 and the present application, the former are not regarded as suggesting the present compounds for the present use. Comparative data is submitted in the present application for the compounds of examples 4 and 8 of D1 (as DD and EE respectively: see p.234). In view of their activity, then, the present compounds, compositions containing them, and their uses are regarded as inventive.

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**Section VII.**

Claims 27-29 are not envisaged by Rule 6.2(a) PCT.

**Section VIII.**

- 1). Many structures in the specification have atoms or groups missing, usually from oxygen or nitrogen atoms. Where it is apparent from a previously given chemical name what the group or atom should be, this should be added for the sake of clarity. Where it is not apparent what the structure should be it is unclear.
- 2). The scope of the term "prodrug" is regarded as unclear.
- 3). There are two claims 8 (on pp.306 and 315. Claims should, however, be numbered consecutively.